

## **REMARKS**

Applicants respectfully request reconsideration of the present Application. Claims 1, 3, 7-9, 11-13, 15, 19-21, 23 and 25-26 have been amended herein. Care has been exercised to introduce no new matter. Claims 2, 5, 14, 18, and 22 have been canceled herein. Claims 1, 3, 7-13, 15, 19-21, 23, and 25-32 are pending and are believed to be in condition for allowance.

### **Rejections based on 35 U.S.C. § 101**

The Office Action states that the claimed invention is directed to non-statutory subject matter. Claims 1-3, 5, 7-15, 18-22 and 29-32 were rejected under 35 U.S.C. § 101 as allegedly reciting a non-statutory method because its process purportedly does not tie to another statutory class or transform underlying subject matter to a different state or thing. Claims 2, 5, 14, 18, and 22 have been canceled herein, thereby rendering rejection of those claims moot.

Claim 1 has been amended to recite a “computer-implemented method” that “uses a processor to receive an identification of a plurality of groups of files.” Moreover, the groups of files are to be represented by a plurality of stack icons, which are stored in a system memory that is connected to the processor by a system bus. Further, claim 1 requires retrieving stack icons from the system memory. As such, Applicants respectfully submit that claim 1 recites a method that is tied to a statutory class, i.e., a machine, and that the rejection of claim 1 and its dependent claims 3, 7-12, and 29 under 35 U.S.C. § 101 should be withdrawn. Claims 1, 3, 7-12, and 29 are believed to be in condition for allowance and such favorable action is respectfully requested.

Claim 13 has been amended to recite a computer storage medium having computer-executable instructions embodied thereon. The United States Supreme Court has recognized that the expansive language of 35 U.S.C. § 101 includes as statutory subject matter

“anything under the sun that is made by man.” *Diamond v. Chakrabarty*, 447 U.S. 303, 308-09 (1980). The USPTO has adopted the Supreme Court’s interpretation and has stated that, in practice, the complete definition of the scope of 35 U.S.C. § 101 “is that any new and useful process, machine, manufacture or composition of matter under the sun that is made by man is the proper subject matter of a patent.” MPEP 2106(IV)(A). More specifically, the MPEP states that “computer programs are often recited as part of a claim.” MPEP 2106.01(I). In considering such claims, “USPTO personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim.” *Id.*; *see also In re Beauregard*, 53 F.3d 1582 (Fed. Cir. 1995). “The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program.” MPEP 2106.01(I). Recently, in *Ex Parte Bo Li*, a decision by the Board of Patent Appeals and Interferences following *Bilski*, the Board deemed a computer implemented program to generate reports to be patent eligible subject matter. *See Ex Parte Bo Li*, Appeal 2008-1213 (BPAI 2008). As such, Beauregard claims remain patent eligible.

Independent claim 13 is directed to “a computer storage medium having computer-executable instructions embodied thereon...” Applicants respectfully submit that a claiming strategy such as that of claim 13 has been deemed proper. *See, e.g., In re Beauregard*, 53 F.3d 1582 (Fed. Cir. 1995). Accordingly, Applicants respectfully submit that claim 13 is directed to statutory subject matter and, as such, request that the rejection of claim 13 under 35 U.S.C. § 101 be reversed and the claim allowed. Claims 15, 19-21, 30, and 32 depend, either directly or indirectly, from independent claim 13. As such, each of claims 15, 19-21, and 30-32

are believed to be in condition for allowance, at least by virtue of its dependency, and such favorable action is respectfully requested. *See* 37 C.F.R. § 1.75(c).

Claims 23-28 were rejected under 35 U.S.C. § 101 as reciting a non-statutory medium because the readable medium recited in the claims includes a communication medium which may be interpreted as signal or carrier waves, which are non-statutory subject matter. Claim 23 has been amended to recite a “computer storage medium.” Accordingly, applicants respectfully submit that claim 23 does not include a communication medium and that claim 23 includes statutory subject matter. Applicants respectfully request that rejection of claims 23-28 under 35 U.S.C. § 101 be withdrawn and that claims 23-28 be allowed.

#### **Rejections based on 35 U.S.C. § 103(a)**

Claims 1-3, 5, 7-15 and 18-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ermel et al., U.S. Patent No. 5,835,094 (hereinafter “Ermel”) in view of Edelman, U.S. Patent No. 5,680,563 (hereinafter “Edelman”) and Mander et al., U.S. Patent No. 6,243,724 (hereinafter “Mander”) further in view of Rosenzweig, U.S. Patent No. 6,950,989 (hereinafter “Rosenzweig”). Claims 2, 5, 14, 18, and 22 have been canceled thereby rendering rejection thereof moot.

Claim 1 is directed to a computer-implemented method for representing files and requires using a processor to receive an identification of a plurality of groups of files, the groups of files to be represented by a plurality of stack icons. Support for this amendment can be found in at least paragraph [0038] of the Specification. Claim 1 requires counting a number of files in each group of files to determine how many files are in each group, wherein the plurality of groups of files includes groups having a range of numbers of files from a largest number of files to a smallest number of files. Support for this amendment can be found in at least paragraphs

[0040] and [0066] of the Specification. Claim 1 also requires dividing the plurality of groups of files by size into three equal fractions of groups of files, which include a smallest third, a medium third, and a largest third. Support for this amendment can also be found in at least paragraphs [0046] and [0066] of the Specification (e.g., dividing a range into three equal ranges). Claim 1 requires assigning a stack icon to each of the three equal fractions, the stack icon being selected from the plurality of stack icons, which include a large-stack icon, a medium-stack icon, and a small-stack icon. Support for this amendment can also be found in at least paragraphs [0046] and [0066] of the Specification. Claim 1 also requires retrieving each of the stack icons and causing them to be displayed on a display device as visual representations of the plurality of groups of files.

While cited references describe displaying stack icons generally, they fail to satisfy *prima facie* requirements of a rejection of claim 1, as amended herein, under 35 U.S.C. § 103. For example, claim 1 outlines a specific methodology by which a limited number of predefined stack icons are selected to represent a plurality of groups of files. Claim 1 requires dividing the plurality of groups of files by size into fractions of groups and assigning an appropriately defined stack icon to each fraction, i.e., a stack icon is selected to represent a group of files based on that group's size relatively to other fractions of the plurality. Aspects of claim 1 enables a group of files to be displayed proportionally as a stack regardless of whether the group includes 5 files or 500 files.

These elements of claim 1 are not described in any of the cited references. For example, Mander merely depicts stack sizes that correspond to the exact number of files within the groups, i.e., a stack representing 5 files would include 5 stacked icons and a stack representing 500 files would include 500 stacked icons. *See Mander* at FIG. 2a; col. 7, ln 35-45

(describes that height increases when a document is added and decreases when a document is removed). Ermel includes deficiencies similar to Mander and describes that stacks include a size that is equal to the number of documents represented by the stack up to a limit (e.g., if a limit is five items, a stack of three items would show three items, a stack of five items would show five items, and a stack of ten items would show five items). *See Ermel* at col. 5, ln 60-65. Likewise, Edelman also shows stacks of items that have a direct correlation to the number of files represented by the stack, e.g., FIG. 5 shows a stack of three items to depict “3 other items.” Rosenzweig depicts shapes that get larger or smaller in proportion to the number of files that are represented by the shape; however, Rosenzweig only describes that a size of one icon is determined based on a relative size to other icons on the same timeline (e.g. icons are in timelines that describe decades, years, months, weeks, days, etc.). For example, Rosenzweig shows in FIG. 8 what appear to be seven different-sized icons, each of which represents a different number of pictures. This is contrary to the invention of claim 1 in which the plurality of groups is first divided into three fractions, and each fraction is assigned a stack icon, such that all groups within one fraction would be depicted by the same icon.

Based on the foregoing, Applicants respectfully submit that claim 1 is patentable over the cited references and that the rejection of claim 1 under 35 U.S.C § 103 should be withdrawn. Claim 1 is believed to be in condition for allowance and such favorable action is respectfully requested.

If an independent claim is nonobvious, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Claims 3, 7-12, and 29 are believed to be patentable based on their direct or indirect dependence from claim 1; however, each of claims 3, 7-12, and 29 also include elements that, when considered in the context of claim 1, are not

found in the prior art. As such, Applicants respectfully submit that claims 3, 7-12, and 29 are patentable over the cited references and that rejection of claims 13, 7-12, and 29 under 35 U.S.C. § 103 should be withdrawn. Claims 3, 7-12, and 29 are believed to be in condition for allowance and such favorable action is respectfully requested.

Independent claims 13 and 23 include subject matter that is similar to claim 1, and both independent claims 13 and 23 are believed to be patentable over the cited references for at least those same reasons state in support of claim 1. For example, both claims recite a methodology for assigning a stack icon to a group of files that includes dividing a plurality of groups into equal fractions. As stated above, none of the cited references describe dividing a plurality of groups into equal fractions of groups in order to assign a predefined stack icon. Accordingly, Applicants respectfully submit that the cited references fail to render obvious claims 13 and 23 and that the rejection of claims 13 and 23 under 35 U.S.C. § 103 should be withdrawn. Claims 13 and 23 are believed to be in condition for allowance and such favorable action is respectfully requested.

If an independent claim is nonobvious, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Claims 15, 19-21, 25-28, and 30-32 are believed to be patentable based on their direct or indirect dependence from either claim 13 or 23; however, each of claims 15, 19-21, 25-28, and 30-32 also include elements that, when considered in the context of either claim 13 or 23, are not found in the prior art. As such, Applicants respectfully submit that claims 15, 19-21, 25-28, and 30-32 are patentable over the cited references and that rejection of claims 15, 19-21, 25-28, and 30-32 under 35 U.S.C. § 103 should be withdrawn. Claims 15, 19-21, 25-28, and 30-32 are believed to be in condition for allowance and such favorable action is respectfully requested.

**CONCLUSION**

For at least the reasons stated above, claims 1, 3, 7-13, 15, 19-21, 23, and 25-32 are believed to be in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of the claims. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned – 816-474-6550 or [adobrien@shb.com](mailto:adobrien@shb.com) (such communication via email is herein expressly granted) – to resolve the same. It is believed that no fee is due, however, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 19-2112.

Respectfully submitted,

/ANDREW D. O'BRIEN/

---

Andrew D. O'Brien  
Reg. No. 57,064

ADO/bp  
SHOOK, HARDY & BACON L.L.P.  
2555 Grand Blvd.  
Kansas City, MO 64108-2613  
816-474-6550